

**REMARKS**

Review and reconsideration on the merits are respectfully requested.

In paragraph 3 at page 2 of the Office Action, the Abstract of the Disclosure stands objected to. Applicants have shortened the Abstract and made it consistent with current independent claim 2. It is believed that the revised Abstract is acceptable, and withdrawal of this objection is respectfully requested.

In paragraph 4 of the Office Action, claims 2 and 3 are objected to because of the use of the terms “of from” when stating a range. The Examiner requests deletion of the word “from”. Applicants have complied with this request, and have amended claims 2 and 3, in a manner which does not reduce their scope, by deleting the word “from”.

Claim 2 stands objected to for the reasons set forth in the remarks of paragraph 5, bridging pages 2-3 of the Office Action. It is believed that the further amendment to claim 2 shown above, indicating more clearly the layer location, but without reducing claim scope, satisfactorily addresses the Examiner’s concern.

Applicants respectfully request entry of the proposed amendments to claims 2 and 3, as well as withdrawal of the stated claim objections.

At pages 3-7, the following four prior art rejections were posed:

- Claims 2-4 held to be anticipated under 35 USC 102(b) by Groff (paragraph 6);
- Claims 2-4 held to be obvious under 35 USC 103(a) over Wenzelberger in view of Brown (paragraph 7);

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-- Claims 2-4 held to be obvious under 35 USC 103(a) over Mamish '225 in view of Deeb (paragraph 8); and

-- Claims 2-4 held to be obvious under 35 USC 103(a) over Shirai (USP 6,037,054 or EP 839 886 A2) in view of Brown, and further in view of Deeb (paragraph 9).

Each of these rejections is respectfully traversed, for the following reasons. Applicants respectfully submit that none of the cited references, alone or in the stated combinations, anticipates (Groff) or renders obvious the subject matter of any of present claims 2-4. In the following response, the focus will be on independent claim 2, since if claim 2 is allowed, its dependent claims 3 and 4 will be allowed as well.

Applicants' claim 2 is directed to a sheet for protecting paint films of automobiles. The sheet comprises a support comprising a polymer film laminated on one or both surfaces of a non-woven fabric. A pressure-sensitive adhesive layer is formed on one surface of the polymer film. The non-woven fabric as claimed has a basis weight of from 5 to 100 g/m<sup>2</sup>.

Groff does not anticipate claim 2. Groff discloses providing a pressure-sensitive adhesive layer on a surface of a non-woven fabric. On the other hand, claim 2 of the present application recites that a pressure-sensitive adhesive layer is formed on a surface of a polymer film. Thus, Groff differs structurally from the present invention and the claims are not anticipated.

Moreover, Groff relates to an improved backing for an electrical-insulating pressure-sensitive adhesive tape. In contrast, the present invention is designed to be used for protecting paint films of automobiles. Thus, assuming that the anticipation rejection is withdrawn, Groff

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would not appear to qualify as analogous art to the extent that any § 103 rejection may be subsumed within the stated grounds.

With regard to the paragraph 7 rejection based on Wenzelberger in view of Brown, the Examiner argues that the primary reference discloses each element of claim 2, but for the basis weight of the fabric; Brown is cited as allegedly supplying this deficiency.

Although the Examiner appears to ignore the intended use of the sheet in claim 2, Wenzelberger also appears to relate to an entirely different field (surgical dressings, insulating wrappings, etc.) than the claimed sheet of the present invention. Thus, this reference is non-analogous art with respect to the present invention, and is unrelated to the problem addressed by Applicants, much less disclosing the claimed solution.

Brown does appear to be in the same general area as the present invention (coverings for equipment and vehicles). However, it is improper to combine its teachings with Wenzelberger, because of their disparate technical association. As to basis weight of the fabric, a range of 1-8 oz/yd<sup>2</sup> (which the Examiner appears to have calculated on the reference document as 32 -255 g/m<sup>2</sup>) is disclosed. Nonetheless, even if, arguendo, such a range overlaps with Applicants' claimed range, there is no motivation or suggestion in the cited art to combine the disclosures as suggested by the Examiner, with an expectation that the advantages attained by the present invention would be obtained.

With regard to the paragraph 8 rejection based on Mamish in view of Deeb, Applicants previously sought to distinguish Mamish (cited alone at the time), arguing that the Examiner had not established a prima facie case of obviousness, i.e., the Examiner had not established that

Mamish discloses the structure and properties of the sheet of claim 2, and why one of ordinary skill in the art would have been motivated to use a fabric basis weight of from 5 to 100g/m<sup>2</sup> from the teachings of Mamish.

Applicants' specification (see page 5) discloses that the recited basis weight provides for the protection of paint films from colliding matters (dust, dirt, etc.), peeling workability after achieving the desired protection, strength, and wrinkle-free adhesion. Mamish may teach the use of the masking tape disclosed therein with reference to the application of paint to automobiles; specifically, the Mamish masking tape may be used to cover areas on which paint is not desired. The masking tape is described as providing "cleaner lines of paint."

Therefore, the Mamish disclosure is really not concerned with the protection of paint films from colliding matters, peeling workability after achieving the desired protection, strength and wrinkle-free adhesion, as in the present invention. Accordingly, Mamish does not appear to provide any motivation to use a fabric having the basis weight recited in Applicants' claims.

The Examiner argues that Mamish does in fact disclose that the non-woven fabric has the recited basis weight of claim 2, referring to column 1, lines 35-62, column 2, lines 9-38 and Example 1. However, the Examiner concedes that Mamish fails to disclose the pressure-sensitive adhesive layer being formed on the surface of the polymer film opposed to the non-woven fabric. Thus, Deeb is cited to supply this alleged deficiency; the Examiner refers to column 3, lines 11-25 and column 7, lines 34-47.

Respectfully, the Examiner's conclusions appear to be based on the impermissible use of hindsight. There is no motivation or suggestion in the cited art to combine the reference

teachings in the manner proposed by the Examiner. Again, the fact that the two reference materials are intended to be used for different purposes is a relevant consideration in the obviousness analysis, and defeats any implication that one skilled in the art would have been motivated to combine the reference teachings.

With regard to the paragraph 9 rejection based on Shirai in view of Brown, and further in view of Deeb, Applicants previously distinguished Shirai (cited alone at the time) by arguing that there is no disclosure in the Shirai reference that teaches or suggests the use of a polymer film and a non-woven fabric. Nor is the basis weight disclosed or suggested in the manner presently claimed.

The Examiner agrees that Shirai fails to disclose the support comprising a thermoplastic polymer film laminated on one or both surfaces of a non-woven fabric which has the basis weight as presently claimed. Brown is again cited as disclosing the basis weight, and Deeb is again cited for its alleged disclosure of the claimed layer structure, wherein the polymer film is imposed between the fabric and the pressure-sensitive adhesive layer.

However, even if, *arguendo*, Shirai could be reasonably interpreted as teaching the combination of a polymer film and a non-woven fabric, the reference does not teach that the pressure sensitive adhesive is formed on the surface of the polymer film (rather than on the non-woven fabric), as recited in Applicants' claim 1. Thus, the rejection as stated requires significant reconstruction of the prior art, and appears to be based on an "obvious to try" rationale and the impermissible use of hindsight with the benefit of the teachings in Applicants' specification.

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The differences between Shirai and the present invention are significant, and are not supplied by the teachings of either Brown or Deeb, because the cited art lacks any motivation or suggestion to combine their teachings, with an expectation that the advantages of the present invention be obtained.

In view of the foregoing, Applicants respectfully submit that none of the stated prior rejections has merit. Accordingly, withdrawal of each of these rejections is respectfully requested.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

Applicant hereby petitions for any extension of time which may be required to maintain the pendency of this case, and any required fee, except for the Issue Fee, for such extension is to be charged to Deposit Account No. 19-4880.

Respectfully submitted,



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**APPENDIX**

**VERSION WITH MARKINGS TO SHOW CHANGES MADE**

**IN THE CLAIMS:**

**The claims are amended as follows:**

2. (Twice Amended) A sheet for protecting paint films of automobiles, which comprises a support comprising a polymer film laminated on one or both surfaces of a non-woven fabric, and a pressure-sensitive adhesive layer formed on one surface of said polymer film opposed to the polymer film surface adhered to the non-woven fabric, wherein said non-woven fabric has a basis weight of [from] 5 to 100 g/m<sup>2</sup>.

3. (Twice Amended) The sheet for protecting paint films of automobiles as claimed in claim 2, wherein said polymer film has a thickness of [from] 5 to 40  $\mu$ m.

**IN THE ABSTRACT OF DISCLOSURE:**

**The abstract is changed as follows:**

**ABSTRACT OF THE DISCLOSURE**

Sheets for protecting paint films of automobiles which can adhere with no wrinkle to paint films of automobiles and cover the same, even in curved surface portions, at a high reliability while achieving excellent protection function to colliding matters, etc. (i.e., the inherent function of protecting sheets) and being easily peeled and removed after completion of the aimed protection, thus preventing the permeation of rainwater, etc. and protecting the paint films of automobiles from being damaged by denaturation, etc. Such a sheet for protecting paint films of automobiles comprises a support (1) comprising a polymer film (12) having a nonwoven

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fabric (11) laminated on one or both surfaces thereof, and a pressure-sensitive adhesive layer (2) formed on one surface of the polymer film, wherein the non-woven fabric has a basis weight of 5 to 100 g/m<sup>2</sup>.

[Lamination of the film on the non-woven fabric makes it possible to provide a sheet which is excellent in durability, function of protecting paint films and peeling workability after the completion of the aimed protection. In this sheet for protecting paint films of automobiles, the non-woven fabric shows an excellent follow-up performance to curved surfaces and thus ensures adhesion with no wrinkle to paint films of automobiles and covering the same, while the film layer prevents the permeation of rainwater, etc.]